

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY LIAO

Appeal No. 96-1834
Application 08/046,945¹

ON BRIEF

Before LYDDANE, MEISTER and FRANKFORT, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

DECISION ON APPEAL

Jerry Liao (the appellant) appeals from the final rejection of claim 1, the only claim present in the application. We reverse and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), will enter a new rejection of the appealed claim.

¹ Application for patent filed April 16, 1993.

The appellant's invention pertains to a method of providing a clothes storage closet using a rectangular closet component of fabric construction material and a skeletal support of interconnected structural members. Of special importance are the steps of assembling and disassembling the skeletal support within the rectangular closet component. The claim is further illustrative of the appealed subject matter and reads as follows:

1. A method of providing a clothes storage closet using a rectangular closet component of fabric construction material having panels forming a top, a bottom, a front, a back, a left side and a right side which cooperate to bound a storage compartment for said closet, and having zipper means in said front panel for gaining access therethrough into said storage compartment, said method comprising the steps of opening said front panel zipper means incident to obtaining access to the interior of said fabric closet component; erecting within said interior of said fabric closet component a skeletal support of interconnected structural members of a type having cooperating male and female connecting means so as to hold in spaced apart relation said top panel, said bottom panel, said front panel, said back panel, said left side panel, and said right side panel without including as a part of said skeletal support any structural members adjacent to said front panel across the area defined thereby to bound therebetween said storage compartment for said closet, said erected skeletal support being sized to have a snug fit within said storage compartment; closing said front panel zipper means so as to both form a closure for said closet and also to draw taut said fabric of said closet component about said skeletal support so that said male and female inter-connecting means are held in place by said fabric tautness during

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use of said closet; and subsequently opening said front panel zipper means and disassembling within said interior of said fabric closet component said male and female interconnecting means of said skeletal support, whereby said clothes storage closet is place into a component storage condition to facilitate storage and transport thereof.

The references relied on by the examiner are:²

Poirier (France) ³	1,445,789	Jun. 06, 1966
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Despujols (France) ⁴	1,467,955	Dec. 26, 1966
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Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Despujols or Poirier. It is the examiner's position that:

The difference between the claimed device and the references is the lack of structural support for the door in the applicant's device. It is well settled in case law that the elimination of an element and its function is an obvious matter of design choice for one having ordinary skill in the art.⁵ Therefore to modify

² In the answer the examiner also listed French Patent No. 1,381,948 to Plastra as being relied on; however, this reference was not used in either the final rejection (see Paper No. 13) or a new ground of rejection in the answer.

³ Translation attached.

⁴ Translation attached.

⁵ We observe, however, that the question of whether the elimination of an element and its function would have been obvious is "is based upon a **determination of obviousness under section 103** and not upon a mechanical rule." *In re Wright*, 343 F.2d 761, 769, 145 USPQ 182, 192 (CCPA 1965)

Despujols or Portier [sic, Poirier] by eliminating of [sic] the door support members and the support for the doors therewith is an obvious matter of design choice for one having an [sic] ordinary skill in the art. [Final rejection, page 2; footnote added.]

In support of this position the answer states that:

The claimed method is inherent to the assembly of the closets of the cited references. Whether the method is specifically recited cannot be readily determined since the references are foreign language documents. The appellant has not provided evidence that the method of assembly of the cited references is anything other than the method recited in the appellant['s] claim. [Page 3.]

We will not support the examiner's position. Even if we were to agree with the examiner that the elimination of the door support members and their function in the wardrobes or suitcases of Despujols and Poirier would have been obvious, we cannot agree that there is a reasonable basis to conclude that the steps of assembly and disassembly specifically recited in claim 1 are "inherent" in these references as the examiner contends. When relying upon the theory of inherency, **the examiner has the initial burden** of establishing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. **Ex parte Levy**, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990).

Here, the examiner has not discharged that initial burden. That is, the examiner has merely made the bald assertion that the method steps set forth in claim 1 are "inherent" without providing any basis in fact and/or technical reasoning whatsoever to support such an assertion. Neither Despujols nor Poirier make any mention of the specifically recited steps of (1) opening the front panel zipper means, (2) erecting a skeletal support of interconnected structural members **within the interior** of the fabric closet component, (3) closing the front panel zipper means and (4) subsequently opening the front panel zipper means and **disassembling the skeletal support within the interior** of the fabric closet component so that the entire device may be stored in a compact condition for storage. Insofar as the disclosure of these two references is concerned the skeletal support might be first assembled and the fabric closet component thereafter formed around the skeletal support, with no disassembly whatsoever being contemplated. Indeed, it does not even appear that Poirier even has the capability of being assembled and disassembled in the claimed manner without destroying the entire device since the frame 9 is attached by soldering (see translation, page 3). Viewing Fig. 2 of Poirier it also appears that the connectors 6, 7 and 8 are similarly attached.

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Even when viewed in a light most favorable to the examiner's position, the most that can be said is that there is a **possibility** that the skeletal supports of Despujols and Poirier might somehow be assembled and disassembled from within the fabric closet component. Inherency, however, may not be established by probabilities or possibilities. **See In re Oelrich**, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and **In re Rijckaert**, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Since we find nothing in either Despujols or Poirier which teaches or fairly suggests the method steps set forth in claim 1, we will not sustain the examiner's rejection of this claim under 35 U.S.C. § 103 based on these two references.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejection.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the requirements of the second paragraph of § 112, a claim must accurately define the invention in the technical sense. **See In re Knowlton**, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Here, claim 1 sets forth that the skeletal support is erected within the interior of the fabric

closet component "without including as a part of said skeletal support any structural members adjacent to said front panel across the area defined thereby" However, viewing Figs. 1, 2 and 4 of the drawing it is readily apparent that the front portion of the members 18 of the skeletal structure do indeed contact the front panel 24. Moreover, the front lower skeletal member 16 can be considered to be "adjacent" the front panel 24. Thus, claim 1 does not define the invention accurately in the technical sense.

In summary:

The examiner's rejection of claim 1 under 35 U.S.C. § 103 is reversed.

A new rejection of claim 1 is made under 35 U.S.C. § 112, second paragraph.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR § 1.197). Should appellant elect to have

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further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED
37 CFR § 1.196(b)

WILLIAM F. LYDDANE)	
Administrative Patent Judge)	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
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CHARLES E. FRANKFORT)	
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